REMARKS

In response to the final office Action dated August 18, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and the following remarks. The Assignee respectfully submits that, when the pending claims are properly interpreted, the pending claims distinguish over the cited documents.

Claims 21-53 are pending in this application. Claims 1-20 were previously canceled.

The United States Patent and Trademark Office (the "Office") rejected claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to Ludtke *et al.*

Claims 21-53, however, are not anticipated or obviated. Because neither *Hendricks* nor *Ludtke* teaches or suggests all the features of the pending claims, the pending claims must distinguish over the cited documents.

Extension of Time

The Assignee respectfully petitions the Commissioner for a two month extension of time from November 18, 2006 to January 18, 2007. The Commissioner is respectfully requested charge the 37 C.F.R. § 1.17 (a) (2) large entity fee of $450.

Claim Interpretation

The Assignee provides the following passages to aid Examiner Ouellette's interpretation of the pending claims. Items 40-42 of the August 18th Final Office Action explain Examiner Ouellette's interpretation of "predicting future buttons pushed by the subscriber." Examiner

Ouellette argues that he cannot find adequate support for this feature, so he interprets this feature as "developing [a] program lineup and integrated targeted advertising based on predicted/analyzed customer program watching habits."

The following passages may help Examiner Ouellette. As the as-filed U.S. Application 10/017,630 states:

> **[0022]** In another embodiment of the present invention, **the merge processor receives a series of subscriber actions, merges the actions with media-content detail, and then attempts to correlate the actions with one another.** The merge processor may also assign a category to the media-content detail and perform a probability analysis on the subscriber content choice information created as a result of the process in order **to predict future subscriber actions.**

U.S. Application 10/017,630 at paragraph [0022] (emphasis added). The same as-filed application also states:

> **[0035]** **The subscriber-action database may include a clickstream database.** A clickstream database is common in Internet monitoring applications. Each time a web-browser user clicks on a link in a web page, a record of that click is stored in a conventional clickstream database. A database that includes similar information for television viewers is disclosed in a patent application filed on May 25, 2000 by Edward R. Grauch, et. al., Serial No. 09/496,92, entitled "Method and System for Tracking Network Use," which is hereby incorporated by reference. In the database described, **each action taken by a television subscriber 123, such as "channel up" and "channel down" are stored in a database with a date-time stamp to allow tracking of the television subscriber's actions.**

U.S. Application 10/017,630 at paragraph [0022] (emphasis added). Moreover, U.S. Application 10/017,742, filed December 14, 2001 and entitled "System and Method for Utilizing Television Viewing Patterns," which was incorporated by reference into U.S. Application 10/017,630, states:

> **[0019]** The media-content database may include television, radio, Internet, and other programming and/or advertising data. **The subscriber-action database includes actions a**

> **subscriber takes to access media content.** For example, in one embodiment of the present invention, **the subscriber-action database comprises a clickstream database.** A clickstream database is common in Internet monitoring applications and similar databases have been described for tracking television subscriber actions. **The clickstream database tracks individual subscriber actions, such as** clicking a hyperlink on a web page or **pushing a button on a television remote control**.

U.S. Application 10/017,742 at paragraph [0019] (emphasis added). The incorporated U.S. Application 10/017,742 also states:

> **[0023]** In one embodiment of the present invention, the merge processor receives a series of subscriber actions, merges the actions with media-content detail, and then attempts to correlate the actions with one another. The merge processor may also assign a category to the media-content detail and perform a probability analysis on subscriber content-choice information **in order to predict future subscriber actions**.

U.S. Application 10/017,742 at paragraph [0023] (emphasis added).

The Assignee thus respectfully requests that Examiner Ouellette revisit his claim interpretation. The Assignee respectfully asserts that the claim element "*predicting future clickstream data that will describe buttons pushed in the future by the subscriber*," as recited in independent claim 21, is fully supported. Moreover, the Assignee also asserts that the claim element "*predict future buttons pushed by the subscriber*," as similarly recited in independent claims 27, 32, and 53, is fully supported. The Assignee thus respectfully requests that Examiner Ouellette revise his claim interpretation in light of the supporting passages cited above.

Rejection of Claims Under 35 U.S.C. § 102 (e)

Claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* As the Assignee has previously argued, the patent to Hendricks *et al.* fails to teach every feature recited in the claims. Independent claims 21, 27, 32, and 53 recite features that are not disclosed by *Hendricks*.

Independent claim 21, for example, recites "*predicting future clickstream data that will describe buttons pushed in the future by the subscriber.*" Independent claims 27, 32, and 53 similarly recite "*predicting future buttons pushed by the subscriber.*"

Hendricks cannot anticipate such features. *Hendricks* makes no disclosure of "*predicting future clickstream data that will describe buttons pushed in the future by the subscriber*" or of "*predicting future buttons pushed by the subscriber*," as recited in the independent claims. As the Assignee has previously acknowledged, *Hendricks* receives "programs watched information" to "develop a program line-up." U.S. Patent 6,463,585 to Hendricks *et al.* (Oct. 8, 2002) at column 11, lines 42-44 and 51-54. *Hendricks* also mentions a remote control and "clickstream data." *Id.* at column 10, lines 38-60 and at column 20, lines 26-27. As *Hendricks* explains, this data is used to develop a "switching plan" for different "feeder channels" that carry advertising and programming. *See id.* at column 6, lines 1-13. When a programming break occurs, the terminal is switched amongst the feeder channels, based upon viewing habits and demographics. *See id.* at column 6, lines 24-42. As *Hendricks* explains, "[c]areful management of the feeder channels, including their dynamic switching, and control of the advertising airing on the feeder channels at any given time can greatly increase the both the advertiser's likelihood of reaching an interested viewer, as well as the likelihood a viewer is interested in a specific advertisement." *See id.* at column 4, lines 43-48.

Hendricks, then, cannot anticipate the pending claims. If the Office must interpret *Hendricks* to make some prediction, the only reasonable interpretation is that *Hendricks* predicts what channel content that may most satisfy a viewer. *Hendricks* cannot be reasonably interpreted to "*[predict] future clickstream data that will describe buttons pushed in the future by the subscriber*" or to "*[predict] future buttons pushed by the subscriber*," as recited in the independent claims.

Moreover, *Hendricks* makes no mention of predicting "*future clickstream data.*" As the Assignee has previously acknowledged, *Hendricks* mentions how "click stream data" may be used to calculate program viewership, targeted viewer groupings, peak viewing times, buy rates,

and advertising rates. *See* U.S. Patent 6,463,585 to Hendricks *et al.* (Oct. 8, 2002) at column 20, lines 19-35. No where, again, does *Hendricks* explain or suggest that click stream data is used to predict future click stream data (or buttons pushed). *Hendricks*, then, cannot be reasonably interpreted to "*[predict] future clickstream data that will describe buttons pushed in the future by the subscriber*" or to "*[predict] future buttons pushed by the subscriber*," as recited in the independent claims.

So, *Hendricks* cannot anticipate the pending claims. *Hendricks* fails to disclose "*predicting future clickstream data that will describe buttons pushed in the future by the* subscriber," as recited in independent claim 21. *Hendricks* also fails to disclose "*predicting future buttons pushed by the subscriber*," as recited in independent claims 27, 32, and 53. Claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53, then, cannot be anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* Examiner Ouellette is thus respectfully requested to remove the § 102 (e) rejection of claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53.

Rejection of Claims Under 35 U.S.C. § 103 (a)

Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to Ludtke *et al.*

If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

For the following reasons, the *prima facie* case for obviousness must fail.

1. The Proposed Combination of *Hendricks* and *Ludtke* Does Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejection Fails

Claims 26, 31, 37, 45-47, and 49 are not obvious in view of *Hendricks* and *Ludtke*. These claims are all dependent upon their respective base claim and, thus, incorporate the same distinguishing features. No where, for example, does the combined teaching of *Hendricks* and *Ludtke* teach or suggest "*predicting future clickstream data that will describe buttons pushed in the future by the* subscriber," as recited in independent claim 21. The combined teaching of *Hendricks* and *Ludtke* also fails to disclose "*predicting future buttons pushed by the subscriber*," as recited in independent claims 27, 32, and 53. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Hendricks* and *Ludtke* to obviate claims 26, 31, 37, 45-47, and 49. Because the proposed combination of *Hendricks* and *Ludtke* does not teach or suggest all the claimed features, the § 103 rejection of these claims must be removed.

2. Because No "Teaching, Suggestion, or Motivation" was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here, however, the Examiner's *prima facie* case fails to include any teaching, suggestion, or motivation. The § 103 (a) rejection makes no attempt to satisfy the Examiner's burden. Examiner Ouellette cites no passage from *Hendricks* or *Ludtke* to support his *prima facie* burden. Examiner Ouellette also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* case for obviousness, then, is at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The

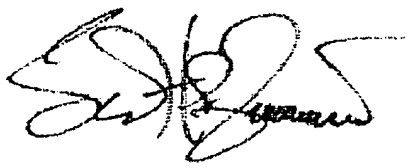
Assignee thus respectfully asserts that the § 103 (a) rejection of claims 26, 31, 37, 45-47, and 49 should be removed.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 26, 31, 37, 45-47, and 49 should be removed.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or *scott@wzpatents.com*.

Respectfully submitted,



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